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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/066,208	04/07/2011	Dennis St. Denis	281-1US	9480

5568 7590 01/31/2017
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EXAMINER

SILBERMANN, JOANNE

ART UNIT	PAPER NUMBER
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3638

MAIL DATE	DELIVERY MODE
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01/31/2017

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DENNIS ST. DENIS

Appeal 2014-006332
Application 13/066,208
Technology Center 3600

Before WILLIAM A. CAPP, BRANDON J. WARNER, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

WARNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Dennis St. Denis (“Appellant”) appeals under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 2, 3, 6, 19, 21, and 23. *See* Appeal Br. 5; Reply Br. 3. Claims 12, 13, 20, and 22 have been allowed by the Examiner, and claims 4, 5, 7–9, and 14–16 have been withdrawn. *See* Appeal Br. 5; Reply Br. 3; Final Act. 1 (Office Action Summary). We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

Appellant's disclosed invention relates to "a warning sign to be mounted on a load bearing wall, which sign becomes visible when renovation or demolition of the wall begins," so as to deter improper or unsafe building renovation. Spec. ¶ 1002; *see id.* ¶¶ 1000–06. Claim 19, reproduced below with emphasis and line breaks added, is illustrative of the subject matter on appeal.

19. *A warning sign* adapted for mounting solely on a load bearing wall in a building, the load bearing wall having an inner supporting structure with vertical spaced-apart studs, the structure covered with an outer layer;

the sign being a single, essentially two-dimensional, member, with an essentially unbroken, planar, viewing surface on one side of the member, and a mounting surface on the other side of the member;

the sign sized to have a width substantially less than the distance between two adjacent studs[;]

the sign having a warning on it's [*sic*] viewing surface relevant to a load bearing wall;

the sign adapted to be mounted on the supporting structure of a load bearing wall with the viewing surface on the sign facing outwardly from the structure and with the supporting structure and the sign normally being covered with the outer layer so the sign is not visible and thus not in use, removal of the outer layer allowing the sign to become visible and thus in use, and to warn the viewer about proceeding.

EVIDENCE

The Examiner relied on the following evidence in rejecting the claims on appeal:

Fatigati

US 6,371,692 B1

Apr. 16, 2002

REJECTIONS

The following rejections are before us for review:

- I. Claims 21 and 23 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Final Act. 2.
- II. Claims 21 and 23 stand rejected under 35 U.S.C. § 101 as reciting an improper process claim and therefore being directed to patent-ineligible subject matter. *Id.*
- III. Claims 2, 3, and 19 stand rejected under 35 U.S.C. § 102(b) as anticipated by Fatigati. *Id.* at 3.
- IV. Claims 6, 21, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fatigati. *Id.* at 3–4.

ANALYSIS

Rejections I and II – Claims 21 and 23 as being indefinite and reciting an improper process claim

Independent claim 21 recites, in relevant part, the “*use of* a warning sign,” followed—not by any method steps—but by recitations regarding the structure of the sign itself. Appeal Br. 23, Claims App. (emphasis added). Appellant asserts that the claim is definite because “[t]he use being claimed relates to the use of a *specific sign*,” and contends that there would be no infringement of the claim “if a person does not use *the claimed sign*.” Appeal Br. 13, 14 (emphasis added).

However, as the Examiner correctly notes, claim 21 is not directed to a sign (as is claim 19), but rather is directed to “use of” a sign without reciting any defined active steps to be performed in a method or process. *See* Final Act. 2. Accordingly, we sustain these rejections for the reasons set forth therein and in light of the Examiner’s responses to Appellant’s

arguments. *See id.*; Ans. 2; *see also* MPEP § 2173.05(q) (regarding issues presented by so-called “use” claims, which accord with the rejections presented by the Examiner here).¹

Rejection III – Claims 2, 3, and 19 as anticipated by Fatigati

The Examiner found that Fatigati discloses a warning sign, including all of the structural limitations recited in these claims. Final Act. 3 (citing Fatigati, Fig. 1). Appellant argues that Fatigati does not show each feature claimed. *See* Appeal Br. 14–17; Reply Br. 5–8. After careful consideration of the rejection before us, Appellant’s arguments do not apprise us of error in the Examiner’s factual findings, which are supported by a preponderance of the evidence. In short, we sustain this rejection based on the findings set forth therein and in light of the Examiner’s responses to Appellant’s arguments. *See* Final Act. 3; Ans. 3. We address Appellant’s principle arguments below simply as a matter of emphasis.

Specifically, Appellant asserts that Fatigati does not disclose a sign that is “a single, essentially two-dimensional” member, as recited in the claims. *See* Appeal Br. 15–16; Reply Br. 5–6. In particular, Appellant contends that Fatigati’s sign includes—not only a two-dimensional member—but also additional elements, such as support legs and pegs. *See id.* However, the relevant inquiry is simply whether Fatigati discloses a sign

¹ We also note that the patent grant of an apparatus claim, such as recited in claim 19, includes the right to exclude “use” of the apparatus claimed. *See* 35 U.S.C. § 271. Thus, it is unclear how the scope of the “use of a warning sign” recited in claim 21 would be distinct from the ordinary use of the “warning sign” recited in claim 19. *See* MPEP § 706.03(k) (regarding substantial duplicate claims that cover the same thing).

that is a single, essentially two-dimensional member, as relied on in the rejection, which it does. *See* Fatigati, Fig. 1; Final Act. 3 (citing same). Fatigati's inclusion of additional elements (such as support legs and pegs) does not diminish the fact that it discloses a single, essentially two-dimensional sign, as the Examiner found. *See id.* As the Examiner explains, these additional elements "are not part of the sign but attachments thereto, much like the supports used to mount Appellant's sign." Ans. 3.

Appellant also asserts that Fatigati does not disclose a sign that meets the size limitation recited in the claims, which is that the sign is "sized to have a width substantially less than the distance between two adjacent studs." *See* Appeal Br. 16–17; Reply Br. 6–7. Although the claims do not recite any particular stud spacing dimension, Appellant urges that typical stud spacing is known to be either 12, 16, or 24 inches. *See* Appeal Br. 16–17, 19–21; *id.* at 24, Evidence App. (and referenced Exhibits A–F). Initially, the Examiner is correct that the claims do not recite a sign in combination with a wall, but rather just a sign that is "adapted for mounting" on a load bearing wall; thus, any sign that is "sized to have a width" that is substantially less than the distance between any two adjacent studs on such a wall meets the claim. *See* Ans. 3. Moreover, even analyzing the claimed "size" of the sign limitation under Appellant's proffered stud spacing, we note that Fatigati discloses that sign sheet 12 is typically "about 18 to 24 inches in height," and the drawings show that each individual sign sheet 12 is taller than it is wide, such that it logically follows that Fatigati's sign is sized to have a width less than 18 to 24 inches, which would fit between two adjacent studs under Appellant's suggested spacing range. Fatigati, col. 2, ll. 60–61, Fig. 1.

After careful consideration of the record before us, Appellant's arguments do not apprise us of error in the Examiner's factual findings that Fatigati discloses a sign as recited in the claims, which are supported by a preponderance of the evidence. Accordingly, we sustain this rejection.

Rejection IV – Claims 6, 21, and 23 as unpatentable over Fatigati

With respect to this rejection, Appellant reiterates the arguments against Fatigati discussed above—namely, that Fatigati is allegedly deficient in disclosing recited structure of the sign itself, and that the “use” recited in these claims requires that the sign be used with certain structure of a load bearing wall. *See* Appeal Br. 17–19. For the same reasons discussed above regarding Rejections I–III, Appellant's arguments do not apprise us of error in this rejection, which we likewise sustain based on the findings and reasoned position set forth therein and in light of the Examiner's responses to Appellant's arguments. *See* Final Act. 3–4; Ans. 3–4.

DECISION

We AFFIRM the Examiner's decision rejecting claims 2, 3, 6, 19, 21, and 23.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED